

REMARKS/ARGUMENT

On March 23, 2005, Applicants received an Office communication on the subject application having a mailing date of October 20, 2004. The Office communication contained a Notice of Non-Compliant Amendment indicating that the amendment document filed by Applicants on July 19, 2004 was non-compliant since it did not contain a complete listing of all the claims (claims 24-27 were missing in the list of claims). The communication set a one month time limit for a response. By Applicants' calculations, a 5-month extension of time is required. While Applicants authorize payment of the 5-month extension of time (\$2,160) in this response to the Office communication, Applicants respectfully request that the extension of time fee be waived due to the delay in Applicants receipt of the Office communication of October 20, 2004. Applicants submit herewith a Request to Waive and/or Refund the extension of time fee and the Declarations of Ben Kroger and Ronald Neerings that the Office communication was not timely received.

1) Claims 1-8, 10-14, 16-20 and 22-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rainish (Rainish et al., US Patent No.: 6,606,490 B1) in view of Eklund (Eklund et al., US Patent No.: 6,181,924 B1). Applicants respectfully traverse this rejection as follows:

Independent Claim 1 requires and positively recites a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: "transmitting a data signal between a mobile station and a base station", "monitoring the data signal received by the mobile station from the base station" and "**disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station**".

Independent Claim 10 requires and positively recites, a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting a data signal between a mobile station and a base station”, “**monitoring the signal to noise ratio (SNR) of the data signal received by the mobile station** from the base station to provide a determination whether the mobile station is in a shadow of the base station” and “**disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station**”.

Independent Claim 16 requires and positively recites, a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting a data signal between a mobile station and a base station”, “transmitting a signal from the base station to the mobile station **that indicates a loss of at least one primary base station rake finger** to provide a determination whether the mobile station is in a shadow of the base station” and “**disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station**”.

Independent Claim 22 requires and positively recites, a method of data communication between a base station and a mobile station over a wireless communication network, the method comprising the steps of: “transmitting a data signal between a mobile station and a base station”, “monitoring the data signal received by the mobile station from the base station”, “**detecting an abrupt change in signal delay received by the mobile station** from the base station to provide an indication of whether the mobile station is in a shadow of the base station” and “**disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station**”.

In contrast, the Rainish reference teaches disabling a receiver when propagation is excellent. Rainish fails to teach or suggest anything regarding “disabling of a transmission”, as taught by the present invention (col. 2, lines 64-67; col. 4, lines 30-40). Accordingly, Rainish fails to teach or suggest, **“disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station”**, as required by Claims 1, 10, 16 and 22. Similarly, Eklund reference fails to teach or suggest, **“disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station”**, as required by Claims 1, 10, 16 and 22. As such, any combination of Rainish and Eklund fails to teach or suggest the limitations of these claims and the 35 U.S.C. 103(a) rejection is overcome.

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is clear from the above analysis that the Examiner did not consider all the words of Claims 1, 10, 16 and 22, as is required by law.

Moreover, the Examiner seems to be misapplying the teaching of Eklund to the present invention. The Examiner states that Eklund teaches “the method of rejecting interfering signals”. But the present invention has nothing to do with rejecting interfering signals – it discusses signal-to-noise ratio (s/n) and structures that impact signal transmission. Accordingly, Eklund fails to teach or suggest the additional requirements of: **“monitoring the signal to noise ratio (SNR) of the data signal received by the mobile station from the base station to provide a determination whether the mobile station is in a shadow of the base station”** and **“disabling transmission of the data signal by the mobile station when the mobile station is in a shadow of the base station”**, as further required by Claim 10, or “transmitting a signal from the base station to the mobile station that indicates a loss of at least one primary base station rake finger to provide a determination whether the mobile station is in a shadow of the base station” and **“disabling transmission of the data signal by the mobile station when the mobile**

station is in a shadow of the base station”, as further required by Claim 16, or “detecting an abrupt change in signal delay received by the mobile station from the base station to provide an indication of whether the mobile station is in a shadow of the base station”, as further required by Claim 22.

Accordingly, the 35 U.S.C. 103(a) rejections of Claims 1, 10, 16 and 22 are overcome.

In proceedings before the Patent and Trademark Office, “the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art”. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984)). “The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**”, In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

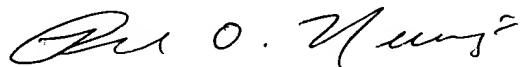
Claims 2-8, 11-14, 17-20 and 23-26 stand allowable as depending from allowable claims and including further limitations not taught or suggested by the references of record.

2) Claims 9, 15, 21 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rainish (Rainish et al., US Patent No.: 6,606,490 B1) in view of Eklund (Eklund et al., US Patent No.: 6,181,924 B1) as applied to claims 7, 13, 19 and 25 above, and further in view of Bergins (Bergins et al., Patent No. 6,564,071 B1). Applicants respectfully traverse this rejection as follows:

Claims 9, 15, 21 and 27 depend directly or indirectly from Claims 1, 10, 16 and 22, respectively. Claims 9, 15, 21 and 27 are allowable for the same reasons given in support of the allowance of Claims 1, 10, 16 and 22. The Bergins reference fails to teach or suggest the previously discussed deficiencies of the Rainish and Eklund references.

Accordingly, Claims 1-27 stand allowable. Applicants respectfully request allowance of the application as the earliest possible date.

Respectfully submitted,



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